

REMARKS

I. Status of Claims

Claims 1-87 and 89-114 are pending. Claims 1-77, 103-104 and 106-113 are withdrawn. Claims 78-102, 105, and 114 are rejected. Claim 78 is amended to indicate that the composition is for caring for and/or making up the lips. Support for this amendment can be found throughout the specification as filed, e.g. at [006] and [011] - [014]. Claims 89-95 have been amended to remedy the antecedent basis. Claim 87 has been amended to incorporate the recitation of the non-ionic polar groups from claim 88. Claim 88 is canceled. Claim 114 is amended to indicate that the cosmetic composition is for caring for and/or making up the lips. Support for this amendment can be found in the specification as filed at [0195]. Accordingly no new matter has been added.

II. Foreign Priority

The Examiner notes that "in the absence of a filed certified copy of the English translation of the foreign priority application, the effective filing date for prior art purposes is considered to be March 6, 2003." Office Action at 3. Applicant submits herewith a certified translation of the French Application, FR 0350035. Therefore, Applicant respectfully requests that the Examiner consider the filing date of this application for prior art purposes as February 25, 2003, the filing date of FR 0350035.

III. Rejection under 35 U.S.C. § 112, first paragraph

The Examiner rejects claims 78-102, 105, and 114 under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner contends that “[n]one of the undisclosed compounds described as having a particular solubility parameter or molecular mass, and/or nonionic polar groups, meet the written description provision of 35 USC § 112, first paragraph, due to lacking chemical structural information for what they are and chemical structures are highly variant and encompass a myriad of possibilities.” Office Action at 4. The Examiner concludes that “only the disclosed chemically structurally defined chemicals, but not the full breadth of the claim(s) meet the written description provision of 35 USC § 112, first paragraph. The species specifically disclosed are not representative of the genus because the genus is highly variant.” Applicant traverses for the following reasons.

In determining compliance with the written description requirement, “the fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.” M.P.E.P. § 2163.02 (citing *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)).

“Possession may be shown in a variety of ways including . . . describing distinguishing identifying characteristics sufficient to show that the applicant was in possession of the claimed invention.” M.P.E.P. § 2163.02 (citing *Amgen, Inc. v. Chugai Pharmaceutical*, 927 F.2d 1200, 1206, 18 USPQ2d 1016, 1021 (Fed. Cir. 1991) (one must define a compound by “whatever characteristics sufficiently distinguish it”)). Further, in showing possession, “[w]hat is conventional or well known to one of ordinary skill in the art need

not be disclosed in detail.” M.P.E.P. § 2163(II)(A)(3)(a) (citing *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384(Fed. Cir. 1986)).

A person skilled in the art would be aware of the general state of the art regarding which compounds are plasticizers. See e.g., Specification at p. 2, [010] (referring to in FR-A-2 782 917). Based on solubility parameters and molecular mass recited in the claims, the present claims serve to sufficiently distinguish the claimed genus of other plasticizers outside the claimed genus. Additionally, the specification states that “[t]he definition of the solubility parameters according to Hansen is well known to the person skilled in the art.” Specification, as filed at p. 14, [068]. Moreover, the specification also states that “[t]he parameters δ_p and δ_h are generally expressed in $(\text{J}/\text{cm}^3)^{1/2}$. They are determined at ambient temperature (25°C) and may be calculated, for example, according to the method disclosed in the above Kao patent.” *Id.* at page 15, [070]. Such a description is sufficient to adequately convey to one skilled in the art that Applicant was in possession of the invention as of the filing date. Accordingly this rejection is improper and should be withdrawn.

IV. Rejections under 35 U.S.C. § 112, second paragraph

The Examiner rejects claims 87-88 under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The Examiner finds the claims indefinite because claim 87 recites the term “wherein the at least one compound comprises no polar group chosen from ionic or non-ionic polar groups”, and claim 88 recites “wherein the non-ionic polar groups are chosen from” See Office Action

at 5. In view of the present amendment to claim 87, and the cancellation of claim 88, this reason for rejection is moot.

The Examiner rejects claims 89-95 for reciting the term "the compound" without proper antecedent basis. The claims have been amended to include the term "at least one" to relate back to the language recited in claim 78. In light of the amendments, this point of the rejection is also moot.

The Examiner rejects claims 89-92 under 35 U.S.C. § 112, second paragraph, for lacking proper antecedent basis. The Examiner contends that claim 78 recites "wherein the solubility parameter, ... , ... ranges from 5.5 to 11," which fails to provide proper support for the solubility parameters < 5.5 as recited in claims 89-92." Office Action at 6. Applicant traverses this point of the rejection.

The specification defines the various three dimensional solubility parameters. See specification at [068] and [069]. Dependent claims 89-92 refer to δ_p , which is the solubility parameter which characterizes the Debye interaction forces between permanent dipoles. Claims 78 recites a limitation for δ_h , which is the solubility parameter which characterizes the specific interaction forces (of hydrogen bond, acid/base, donor/receptor type, etc.). These are different properties and therefore there is no inconsistency with the antecedent claims. Hence, the antecedent basis is proper and this point of the rejection should be withdrawn.

The Examiner rejects claims 97 and 99 for lacking proper antecedent basis. Applicant disagrees, and point out that both claims 97 and 99 are each indirectly dependent on claim 78, which recites both the at least one particle and the at least one

compound. Therefore, a proper antecedent basis exists for the ratio recited in claims 97 and 99.

V. Rejection under 35 U.S.C. § 102

A. Ferrari

The Examiner rejects claims 78-100, 102, 105, and 114 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Application Publication No. 2002/0164297 to Ferrari et al. ("Ferrari"). The Examiner states that "[t]he dispersion exemplified by Ferrari et al., which is identical to the polymer dispersion component encompassed by the instant claims, satisfies the embodiment "b" as recited in independent claims 78 and 114. The hydrogenated polyisobutene exemplified by Ferrari et al. reasonably satisfies the liquid fatty phase component of the instant claimed composition i.e. embodiment "a" of independent claims 78 and 114." Office Action at 7. The Examiner then alleges that the at least one compound having a solubility parameter, δ_h , ranging from 5.5 to 11 $(\text{J}/\text{cm}^3)^{1/2}$, the compound being present in an amount sufficient to plasticize the at least one polymer particle, "given its broadest reasonable possible interpretation is construed to encompass diisostearyl maleate exemplified by Ferrari." *Id.* at 8. Applicant respectfully disagrees and traverse the rejection.

Not every element as set forth in the claims is expressly found in Ferrari. Ferrari does not teach the claimed compound recited in element "c)" of claim 78. The Examiner construes that diisostearyl maleate inherently possesses the claimed solubility parameter, δ_h , ranging from 5.5 to 11 $(\text{J}/\text{cm}^3)^{1/2}$. However, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to

establish the inherency of that result or characteristic. M.P.E.P. § 2112 IV (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993)). Here, the Examiner has not provided any basis in fact or technical reasoning to reasonably support the contention that diisostearyl maleate possesses the claimed property. As a consequence, the Examiner has not shown that diisostearyl maleate is encompassed by the present claims and that Ferrari meets all of the limitations of independent claims 78 and 114.

Applicant respectfully submits that Ferrari fails to teach all of the limitations highlighted above. Accordingly, this rejection is improper and Applicant respectfully requests its withdrawal.

B. Chevalier

The Examiner has rejected claims 89-92 under 35 U.S.C. § 102(a) as allegedly being anticipated by U.S. Patent No. 6,361,782 to Chevalier et al. ("Chevalier"). Office Action at 8. The Examiner states that the "teaching of Chevalier et al. overlaps with the instant claimed composition comprising a stabilized polymer particle dispersed in a liquid fatty phase (col. 14, lines 26-39)." *Id.* at 9-10. The Examiner also alleges that "Chevalier et al. [teaches] compositions comprising non-volatile primary oils, including n-butyl acetate, dibutyl phthalate, which reasonably satisfy the embodiment "c" recited in claims 78 and 114 . . . as evidenced by the teaching of Uchiyama et al. (US Patent Application Pub. No. 20030224030 A1) of plasticizers, including said non-volatile oils disclosed by Chevalier et al." *Id.* at 9. The Examiner recognizes that Chevalier teaches that the non-volatile phase has a solubility parameter $\leq 5 \text{ (J/cm}^3)^{1/2}$. *Id.* The Examiner

contends that “[t]he solubility parameters recited in claims 89-92 overlap with the teaching of Chevalier et al.” *Id.* The Examiner Applicant respectfully disagrees and traverse this rejection for the following reasons.

As an initial matter, Applicant notes that claims 89-92 depend, either directly or indirectly, on independent claim 78. However, claim 78 was not rejected by the Examiner. Accordingly, clarification is requested regarding the identification of the claims being rejected by Chevalier. If the Examiner concludes, as Applicant believes, that Chevalier fails to teach the limitations of claim 78, then the rejection of dependent claims 89-92 must be withdrawn.

To this end, Applicant respectfully submits that every element as set forth in the claims is expressly found in Chevalier. Chevalier refers to oils of solubility parameter $\delta_h \leq 5$ as primary oils. See Chevalier Col. 7, lines 28-30. Chevalier also lists secondary oils has having the solubility parameter $\delta_h \leq 5$. See *Id.* lines 32-36. As the Examiner states, Chevalier lists n-butyl acetate and dibutyl phthalate under the category of primary oils. Independent claims 78 and 114 recite “at least one compound having a solubility parameter, δ_h , ranging from 5.5 to 11 (J/cm³)^{1/2}.” As discussed above regarding the § 112, second paragraph, rejection of claims 89-92 above, δ_h is not the same as δ_p . Chevalier’s primary oils have a solubility parameter, δ_h , with values which fall outside the claimed range of independent claim 78. Since the independent claim is not anticipated by Chevalier, the dependent claims, 89-92, with an additional limitation regarding δ_p , are also not anticipated. Hence this rejection is improper and Applicant respectfully requests its withdrawal.

Nevertheless, in an attempt to advance prosecution of this application, Applicant amended independent claims 78 and 114 to further recite that the composition "is for caring for and/or making up the lips." In contrast, Chevalier is not directed to a composition for caring for and/or making up the lips. Chevalier is directed towards compositions suitable for cosmetics and dermatology, and in particular allow for camouflaging marks, skin pigmentation defects, dyschromia and couperose. Chevalier does not make a single reference to lip care or make up in its entire specification.

The Examiner also states "[t]he limitations with respect to molecular mass, for example recited in claims 83, 84, 85, and 86; and the limitations with respect to mass ratio, for example recited in claims 96, 98, and 100 are construed to be inherent characteristics of the claimed composition." Office Action at 8. The Examiner has not explicitly stated that these claims are rejected, based on Chevalier. Nevertheless, the Examiner's allegation of inherency lacks any basis in fact or technical reasoning.

Applicant respectfully submits that Chevalier fails to teach all of the limitations highlighted above. Accordingly, this rejection is improper and Applicant respectfully requests its withdrawal.

VI. Rejection under 35 U.S.C. § 103

The Examiner rejects claims 78-102, 105, and 114 under 103(a) as being unpatentable over Chevalier and Ferrari in view of U.S. Patent Application Publication No. 20030224030 A1 to Uchiyama et al. ("Uchiyama"). The Examiner cites to Uchiyama to show the general state of the art regarding plasticizers (para 0041). Office Action at 11. The Examiner contends "[t]he above references in combination make

clear that plasticizers are included in the compositions taught by each reference. Thus, it is obvious to combine two compositions each of which is taught by the prior art to be useful for same purpose because the idea of combining the above cited references flows logically from their having individually been taught in the prior art.” *Id.* at 11-12. Applicant respectfully disagrees and traverse this rejection for the following reasons.

“The proper analysis is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all of the facts.” M.P.E.P. §2141 (III). Applicant takes the position that after consideration of all the facts herein, the combination and modification of references relied on by the Examiner does not render the present claims obvious.

As an initial matter, several basic factual inquiries must be made in order to determine the obviousness or non-obviousness of claims of a patent application under 35 U.S.C. § 103. These factual inquiries, set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459, 467 (1966), require the Examiner to:

- (1) Determine the scope and content of the prior art;
- (2) Ascertain the differences between the prior art and the claims in issue;
- (3) Resolve the level of ordinary skill in the pertinent art; and
- (4) Evaluate evidence of secondary considerations.

The obviousness or non-obviousness of the claimed invention is then evaluated in view of the results of these inquiries. *Graham*, 383 U.S. at 17-18, 148 U.S.P.Q. at 467; see also *KSR Int'l Co. v. Teleflex Inc.*, 82 U.S.P.Q.2d 1385 (U.S. 2007).

Finally, “[a] *prima facie* case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention.”

M.P.E.P. 2144.05 III.

The combination of references by the Examiner would not lead one of ordinary skill in the art to arrive at the present composition. To rely on a reference under 35 U.S.C. § 103, it must be analogous prior art. M.P.E.P. 2141.01. Here, the three references are in disparate fields. While both Ferrari and Chevalier are directed to cosmetic compositions, Chevalier is directed compositions to mask dyschromias. Uchiyama teaches fabric refresher products.

Furthermore, the combination of the three references teaches away from the claimed composition. The Examiner states

Chevalier et al. [] compositions comprising non-volatile primary oils, including n-butyl acetate, dibutyl phthalate, which reasonably satisfy the embodiment "c" recited in claims 78 and 114 (see col. 7, line 51 to col. 8, line 61; see also reference claim 8) as evidenced by the teaching of Uchiyama et al. (US Patent Application Pub. No. 20030224030 A1) of plasticizers, including said non-volatile oils disclosed by Chevalier et al.

Office Action at 9. As stated earlier, the Examiner incorrectly argues that primary oils of Chevalier reasonably satisfy element “c” of claims 78 and 114 because the prior art teaches away from the claimed solubility range. However, the Examiner’s argument is based on the categorization that some of the primary oils listed in Chevalier are plasticizers. Chevalier refers to oils of solubility parameter $\delta_h \leq 5$ as primary oils. See Chevalier Col. 7, lines 28-30. “These primary oils also make it possible to dissolve oils of solubility parameter $\delta_h \leq 5$, which are referred to as secondary oils, thus making these oils compatible with the polymer particles and the dyestuff.” *Id.* at lines 32-36. Hence,

upon reading Chevalier, one would avoid primary oils, some of which are recognized by the Examiner as plasticizers, with a solubility parameter $\delta_h > 5$. Therefore, the combination of references teaches away from compounds with a solubility parameter $\delta_h > 5$. The present claims require "at least one compound having a solubility parameter, δ_h , ranging from 5.5 to 11 (J/cm³)^{1/2}." Therefore this rejection is improper and should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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